

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL W. TETHER
and
GREGORY S. HERBIG

Appeal No. 97-0608
Application 08/287,143¹

ON BRIEF

¹ Application for patent filed August 8, 1994. According to appellants, the application is a continuation of Application 08/078,405, filed June 17, 1993, abandoned; which is a continuation-in-part of Application 07/959,774, filed October 13, 1992, now U.S. Patent No. 5,254,389, issued October 19, 1993; which is a continuation-in-part of Application 07/804,995, filed December 11, 1991, now U.S. Patent No. 5,188,880, issued February 23, 1993.

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Before STONER, Chief Administrative Patent Judge, and MEISTER,
FRANKFORT, PATE and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 12 through 20 and from the examiner's refusal to allow claims 1 and 3 through 11 as amended subsequent to the final rejection in a paper filed November 16, 1995 (Paper No. 10). Claim 2 has been canceled.²

Appellants' invention relates to a process for manufacturing void fill material. As is apparent from a review of the specification, void fill material constitutes

² While the examiner has approved entry (in-part) of the amendment filed November 16, 1995, we note that such changes have not been clerically entered in the file in the manner specified by the examiner. Correction of this oversight should be attended to during any further prosecution of this application before the examiner.

relatively small pieces of material (e.g., polystyrene "peanuts," shredded paper, or popcorn) used to fill the empty space around a packaged item in a package and to cushion the product or item and prevent movement of the item during shipping and handling. This type of

fill material is also sometimes referred to as "dunnage." The void fill material of the present application is derived from sheet material, such as corrugated cardboard. More specifically, it is explained on page 7 of the specification that

[t]his invention provides for the easy conversion of sheet material into a void fill material having interlocking members. The cardboard material is cut by the cutter and anvil cylinder arrangement wherein the interlocking members of the void fill material are formed by the cutting blades on the cutter cylinder.

The sheet material, such as corrugated cardboard, is environmentally safe as opposed to void fill material containing CFCs. By recycling cardboard or sheet material through the present invention, the cardboard or sheet material will not be placed in landfills thereby providing another beneficial environmental impact. Corrugated void fill is easy to create,

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handle and dispense from a hopper assembly, and is inexpensive compared to many void fill materials. Additionally, this material does not possess the detrimental side-effects of releasing oils, ink or residue onto the packaged material or attracting insects like cornstarch or popcorn void fill materials.

Claims 1, 12 and 16 are representative of the subject matter on appeal and a copy of those claims, as they appear in Exhibit A of appellants' brief, is attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Reba et al. (Reba)	4,499,801	Feb. 19, 1985
Barben et al. (Barben)	5,027,509	July 2, 1991

Prior art references applied by this panel of the Board in new rejections of certain of the appealed claims under 37 CFR § 1.196(b) are:

Kesten	3,766,814	Oct. 23, 1973
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MacGregor	4,997,134	Mar. 5,
1991		
Watts	5,181,614	Jan. 26,
1993		
		(filed Apr. 5,
1991)		

Claims 1 and 3 through 12 stand rejected under 35
U.S.C. § 103 as being unpatentable over Barben.

Claims 13 through 20 stand rejected under 35 U.S.C.
§ 103 as being unpatentable over Barben in view of Reba.

Rather than reiterate the examiner's explanation of
the above-noted rejections and the conflicting viewpoints
advanced by the examiner and appellants regarding the rejec-
tions, we make reference to the examiner's answer (Paper No.
18, mailed
August 27, 1996) for the examiner's reasoning in support of

the rejections, and to appellants' brief (Paper No. 15, filed
April 26, 1996) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of this review, we have made the determination that the examiner's rejections under 35 U.S.C. § 103 will not be sustained. Our reasons follow.

Looking at Barben, we note that this patent is directed to a method for manufacturing a tool cylinder (e.g., a cutting cylinder 1000) for use in a rotary machine for processing continuously at high speeds a web-like or sheet-like workpiece, such as, for instance, sheets of paperboard for the manufacture of packaging boxes. The patentee specifically mentions (column 1) packaging boxes in the form of flip-top type cigarette boxes for luxurious cigarettes, which are semi-rigid boxes of which the top bends backwards in order to render the cigarettes very accessible. While it is certainly true that Barben teaches or suggests

inserting a sheet of paperboard between a cutting cylinder (1000) and an anvil or counter-cylinder (250), and cutting the sheet of paperboard into a plurality of pieces (in the form of packaging box blanks), we must agree with appellants that one of ordinary skill in the art would not have viewed the packaging box blanks of Barben as being "void fill material," or have viewed the apparatus and process disclosed in Barben as being in any way responsive to the process of manufacturing void fill material as set forth in appellants' claims on appeal.

Nor can we agree with the examiner's position that the use of the packaging box blanks of Barben as void fill material "would have been considered an obvious choice of use of a final product to one of ordinary skill in the art" (answer, page 5). Absent hindsight, one of ordinary skill in the art simply would not have reasonably viewed the packaging box blanks of Barben as being void fill material, nor reasonably considered them for such a use. We view this position on the

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examiner's part to be both unreasonable and unsupported by any factual evidence of record.

As for the examiner's further reliance on Reba in combination with Barben in the § 103 rejection of claims 13 through 20, we share appellants' view that the examiner's position epitomizes improper hindsight reconstruction of the claimed subject matter. Like appellants, we find no teaching, suggestion or incentive in the applied references for using a Coanda effect nozzle like that of Reba in the packaging box blank cutting mechanism of Barben and, as noted by appellants, the examiner has pointed to none. While the trim segment removal means (120) and Coanda nozzle (132) of Reba are used to remove the trim strip segments (32) from the slitters therein, no such trim strip segments or slitters are present in Barben.

Lacking any reasonable teachings in the prior art itself which would appear to have fairly suggested the claimed

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subject matter as a whole to a person of ordinary skill in the art, or any viable line of reasoning as to why such artisan would have otherwise found the claimed subject matter to have been obvious in light of the teachings of the applied references, we must refuse to sustain the examiner's rejections of claims 1

and 3 through 20 under 35 U.S.C. § 103.

In light of the foregoing, the decision of the examiner is reversed.

Under the authority provided us by 37 CFR § 1.196(b), we enter the following new grounds of rejection against certain of the appealed claims.

Claims 12, 13, 15, 16 and 18 are rejected under 35 U.S.C. § 102(b) as being anticipated by MacGregor. In MacGregor

Figure 9, there is shown a document shredding machine which includes a rotary cutting member and a rotary anvil member

(80, 82). During the process by which the document (D) therein is to be shredded, a sheet material member or strip portion (S) is fed between the rotary cutting and anvil members and is cut into a plurality of small pieces (B). The pieces (B) are collected in the end cap (76b) of the shredder or are otherwise collected in an adjacent container (see col. 5, lines 10-16). Given appellants' concession on page 2 of the specification that shredded paper is known for use as void fill material, we consider it appropriate to denote the small pieces of shredded paper (B) in MacGregor as being "void fill material."

Claims 16 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Watts. Watts discloses a mechanism and process for making dunnage or void fill material. In Figure 3, and as described in column 6, line 26 et seq., Watts discloses a portion of the mechanism which includes a cutting surface (66) and an anvil surface (67), as well as the steps of inserting a sheet material (34) between the cutting and anvil

members, cutting the sheet material into a plurality of pieces of void fill material, ejecting the pieces from the cutting surfaces, and collecting the pieces of void fill material for dispersal around a packaged item inside a package (see, e.g., Figures 1 and 2). As is apparent from Figures 8B and 9B, and as clearly seen in Figure 2, the pieces of dunnage or void fill material in Watts are "capable of possessing an interlocking relationship with other sections of ones of said pieces of void fill material," as required in appellants' claim 20 on appeal.

Claims 1, 3, 8, 12 through 18 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative under 35 U.S.C. § 103 as being unpatentable over Kesten. Kesten discloses a die-cutting assembly and method of operation thereof which includes providing a rotary cutting assembly (10), providing a rotary anvil member (62), feeding a sheet material (not shown) between the rotary cutting and anvil members, cutting the sheet material into a plurality of pieces (by cutting

elements 14), ejecting the pieces from the cutting surfaces by pressurized air exiting passageways (16), and collecting these scrap pieces for later disposal. While we recognize that Kesten does not specifically designate the small scrap elements ejected from the cutter as being "void fill material," we nonetheless consider that such small pieces of material would be clearly capable of such a use and would be considered by one of ordinary skill in the art, in the same manner as shredded paper, to be "void fill material."

Contrary to appellants' arguments (brief, pages 7-8), the claims on appeal do not include limitations directed to the subsequent placement of the pieces of void fill material around a packaged item inside a container, but merely set forth that the pieces of void fill material are "for" subsequent placement around a packaged item inside a container. The pieces of scrap ejected from the cutters in Kesten are clearly capable of such a latter use, and to the extent that the language "void fill material" must be given weight in the claims on appeal, it is our opinion that it

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would have been obvious to one of ordinary skill in the art that the small pieces of scrap material may be

considered to be "void fill material," and to so use the small scrap pieces resulting from the process in Kesten.

Regarding the requirement in appellants' claims 1 and 20 that the pieces of void fill material be "capable of forming [or of possessing] an interlocking relationship with other sections of other of said pieces of void fill material," we note that the configuration of the scrap pieces in Kesten exiting from the cutting elements (14), as seen in Figure 1, will inherently possess this capability.

In addition to the foregoing references applied by this panel of the Board in the new grounds of rejection above, we direct the examiner's attention to Bishop (U.S. Patent No. 3,381,563) for another rotary cutting apparatus and process which produces small irregular, interlocking pieces of material from a web or sheet of material. Again, we consider

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that the small pieces of sheet material (puzzle pieces) of Bishop would be clearly capable of use as "void fill material" and would be considered by one of ordinary skill in the art, in the same manner as shredded paper, to be "void fill material." Hutchinson et al. (U.S. Patent No. 3,875,836) discloses another rotary cutting apparatus wherein pressurized air is used to eject the cut items from the cutting surface of the cutting cylinder.

Given that the references we have cited and applied above are merely those found in a cursory search of the areas listed below, we REMAND this application to the examiner for a complete search of the designated art areas. See particularly, Class 83, subclasses 32, 99, 300-302, 346, 347, 906 and 923. Moreover, given the classification of the MacGregor patent and the Watts patent applied above, we feel

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it would be merely prudent to at least inquire in Classes 206 and 241 also.³

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by

final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

³ In addition to the above search areas, we are also aware of corrugated cardboard dividers used in beverage boxes to define spaces for the bottles and protect the bottles therein during shipping and handling. These dividers usually interlock with at least one other divider at slits therein to define the spaces for the bottles. Given the nature and use of these dividers, we consider that these cardboard dividers would be broadly viewed by one of ordinary skill in the art as being "void fill material" and also that they are most likely formed by some type of cutting process, such as by either stamping or rotary cutting. Thus, these cardboard divider elements would appear to be particularly relevant to the presently claimed subject matter. Accordingly, we encourage the examiner to pursue this field of search also.

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37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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This application, by virtue of its "special" status,
requires an immediate action, MPEP § 708.01(d).

REVERSED AND REMANDED, 37 CFR § 1.196(b)

	BRUCE H. STONER, JR.)	
	Chief Administrative Patent Judge)	
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	JAMES M. MEISTER)	
	Administrative Patent Judge)	
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	CHARLES E. FRANKFORT)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS
AND)	INTERFERENCES
)	
)	
	WILLIAM F. PATE, III)	
	Administrative Patent Judge)	
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1. A process for manufacturing void fill material comprising the steps of:

providing a cutting surface;

providing an anvil surface opposing said cutting surface;

inserting a sheet material between said cutting surface and said anvil surface; and

cutting said sheet material into a plurality of pieces of void fill material wherein one of said pieces of said void fill material possesses at least one primary section extending from a primary plane, wherein said primary section is capable of forming an interlocking relationship with other sections of other of said pieces of void fill material for subsequent placement around a packaged item inside a container for the package item.

12. A process for manufacturing void fill material comprising the steps of:

providing a rotary cutting assembly;

providing a rotary anvil surface opposing said rotary cutting assembly;

inserting a sheet material between said rotary cutting surface and said rotary anvil surface; and

cutting said sheet material into a plurality of pieces of said void fill material for subsequent dispersal around a packaged item inside a package.

16. A process for manufacturing void fill material comprising the steps of:

providing a cutting surface;

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providing an anvil surface opposing said cutting surface;

inserting a sheet material between said cutting surface and said anvil surface;

cutting said sheet material into a plurality of pieces of void fill material;

ejecting said plurality of pieces of void fill material from said cutting surface; and

collecting said pieces of void fill material for subsequent dispersal around a packaged item inside a package.